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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/239,414	01/28/1999	JAMES S. UMSTETTER	99P744US	6061

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SIEMENS CORPORATION
INTELLECTUAL PROPERTY DEPARTMENT
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EXAMINER

TRAN, CON P

ART UNIT PAPER NUMBER

2644

DATE MAILED: 11/07/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/239,414

Applicant(s)

UMSTETTER ET AL.

Examiner

Con P. Tran

Art Unit

2644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-9,17,19 and 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-9,17,19 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Response to Amendment

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn. The Amendment After Final dated 09/08/03 has been entered.

Claim Objections

2. Claim 1 is objected to because of the following informalities: In claim 1, line 1 states "telephone=s". Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. **Claims 1-3, 5-9, 17, and 19-20** are rejected under 35 U.S.C. 102(b) as being anticipated by Bentley et al. U.S. Patent 5,727,047 (hereinafter, "Bentley").

Regarding **claim 1**, Bentley teaches a method for extending a telephone's capability (see Fig. 1, 2, 3, 4, and respective portions of the specification) comprising steps of:

enabling a telephone (300, Fig. 1, col. 2, line 65 – col. 3, line 8; standby mode) to store call-related data in memory located within the telephone (i.e., incoming call information is stored in the Call Log; see col. 11, lines 51-59);

enabling a computer (110, Fig. 1, col. 2, line 65 – col. 3, line 8; powered-on, col. 4, lines 14-20) to alternately store the call-related data in memory located within the computer (see col. 27, lines 8-17);

receiving first call-related data at the telephone (i.e., checks for call identification information, see col. 11, lines 51-59);

recognizing that the first call-related data is to be stored in memory (i.e., incoming call information is stored in the Call Log; see col. 11, lines 51-59);

determining, within the telephone, whether the first call-related data will be stored in the telephone memory or the computer memory (see Fig. 4; col. 27, lines 8-17); and

storing the first call-related data in the telephone memory or the computer memory based upon the determination (see Fig. 4; col. 27, lines 8-17);

wherein the telephone is enabled to perform telephone functions independently of the telephone (col. 2, lines 10-14; col. 27, lines 18-22).

Regarding **claim 2**, Bentley further teaches a step of establishing a direct data connection between the telephone (through RS-232) and the computer and the computer being structurally separate components (Fig. 1 and respective portions of the specification; col. 4, lines 18-35; col. 27, lines 17-22).

Regarding **claim 3**, Bentley further teaches the method as claimed in claim 2 wherein the telephone (300) and the computer (110) are located within a common workspace, the step of establishing the direct data connection (e.g., for transferring call ID information) being independent of providing connectivity for receiving the first call-related data (see Fig. 1 and respective portions of the specification; col. 2, lines 10-14; col. 27, lines 17-22).

Regarding **claim 5**, Bentley further teaches a method as claimed in claim 1 wherein the step of determining includes steps of:

monitoring storage availability within the telephone memory; comparing the monitored storage availability to a storage threshold that is related to the telephone memory (i.e. 50% full; first step of Fig. 4); and storing the first call-related data in the computer memory when the storage threshold related to the telephone memory is exceeded (i.e., if memory on the telephone is greater than 50% full then transfer; Fig. 4; col. 2, lines 10-14; col. 27, lines 18-22).

Regarding **claim 6**, Bentley further teaches a step of retrieving call-related data (i.e., download call ID information) from the computer to the telephone in response to signals from the telephone (see col. 4, lines 21-29).

Regarding **claim 7**, Bentley further teaches a method as claimed in claim 1 further including steps of (see Fig. 1, 2, 3, 4, and respective portions of the specification):

- enabling a first processor (call ID decoder and sniff circuit 112) located within the telephone to process data received at the telephone (col. 3, lines 22-26; stored in the Call Log; see col. 11, lines 51-59);

- enabling a second processor inherently located within the computer to process (e.g., upload, download) data received at the telephone (col. 4, lines 21-29);

- recognizing that the first call-related data received at the telephone is to be processed (e.g., stored; see col. 11, lines 51-59); and

- determining, within the telephone, whether the first call-related data (call ID information) will be processed (e.g., transferred, stored) by the first processor or the second processor (col. 4, lines 21-29; col. 27, lines 8-17), the telephone thereby controlling the first call-related data (call ID information) to which of two structurally separate components (telephone 300 or computer 110; Fig. 1) will perform processing thereon (col. 4, lines 18-35).

Regarding **claim 8**, , Bentley teaches the method as claimed in claim 1 further including a step of utilizing a processor of the computer to process (i.e., transfer) at least a portion of the first call-related data in response to instructions from the telephone (col. 4, lines 21-29; col. 27, lines 8-17).

Regarding **claim 9**, Bentley further teaches a step of establishing a data connection between the telephone (300) and the computer (110) by connecting the telephone separately to a telephone network (through RJ-11) and to the computer (through RS-232; Fig. 1 and respective portions of the specification; col. 2, line 65 – col. 3, line 8; col. 27, lines 17-22).

Regarding **claim 17**, Bentley teaches a method for extending a telephone's capability (see Fig. 1, 2, 3, 4, and respective portions of the specification) comprising steps of:

enabling a first processor (call ID decoder and sniff circuit 112) resident in the telephone to process data received at the telephone (col. 3, lines 22-26; stored in the Call Log; see col. 11, lines 51-59);

enabling a second processor inherently resident in the computer to process (e.g., upload, download) data received at the telephone (col. 4, lines 21-29);

establishing a direct data connection between the telephone (through RS-232, Fig. 1; col. 2, line 65 – col. 3, line 8), wherein and the computer and the computer being structurally separate components located within a common workspace (col. 4,

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lines 18-35) and wherein the telephone is configured to perform telephone functions independently of the telephone (col. 2, lines 10-14; col. 27, lines 17-22);

receiving call-related data at the telephone (i.e., checks for call identification information, see col. 11, lines 51-59);

recognizing that the first call-related data required further processing (i.e. 50% full; first step of Fig. 4; col. 27, lines 17-22);

determining, using automated processing capabilities of the telephone processing (i.e. 50% full; first step of Fig. 4), whether the call-related data will be processed in the first processor (of telephone) or the second processor (of computer), including basing said determination upon automated processing performed by the telephone (i.e., if memory on the telephone is greater than 50% full then transfer; Fig. 4; col. 2, lines 10-14; col. 27, lines 18-22); and

processing the call-related data in either the telephone or the computer based upon the determination made using the automated capabilities (i.e., if memory on the telephone is greater than 50% full then transfer; Fig. 4; col. 2, lines 10-14; col. 27, lines 18-22).

Regarding **claim 19**, Bentley further teaches a method as claimed in claim 17 (see Fig. 1, 2, 3, 4, and respective portions of the specification) including steps of:

enabling a telephone (300, Fig. 1, col. 2, line 65 – col. 3, line 8; standby mode) to store data received at the telephone in memory located within the telephone (i.e., incoming call information is stored in the Call Log; see col. 11, lines 51-59);

enabling a computer (110, Fig. 1, col. 2, line 65 – col. 3, line 8; powered-on, col. 4, lines 14-20) to store data received at the telephone in memory located within the computer (see col. 27, lines 8-17);

recognizing that the received call-related data is to be stored in memory (i.e., incoming call information is stored in the Call Log; see col. 11, lines 51-59);

determining, within the telephone, whether the call-related data will be stored in the telephone memory or the computer memory (see Fig. 4; col. 27, lines 8-17); and

storing the call-related data in the telephone memory or the computer memory based upon the determination (see Fig. 4; col. 27, lines 8-17);

Regarding **claim 20**, Bentley further teaches the steps of determining are performed by an application programming interface residing within the telephone (see flow chart of Figure 4 through Figure 7; col. 2, lines 55-58; col. 4, lines 38-52).

Response to Arguments

5. Applicant's arguments with respect to claims 1-3, 5-9, 17, and 19-20 have been considered but are moot in view of the new grounds of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Con P. Tran, whose telephone number is (703) 305-2341. The examiner can normally be reached on M - F (8:30 AM - 5:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Forester W. Isen can be reached on (703) 305-4386. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Customer Service Office at telephone number (703) 306-0377.

cpt CPJ
October 31, 2003


XU MEI
PRIMARY EXAMINER